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REMARKS

Claims 1-21 are pending in this application.

Applicant thanks Examiner Yang for the withdrawal of the previous rejections.

The Office Action rejects claim 1 under the judicially created doctrine of obviousness type double patenting over claim 1 of Goldberg (U.S. Patent No. 5,530,437) and LaPorta et al. (U.S. Patent No. 5,918,158). The Office Action also rejects claims 2, 10, 16, and 19-21 under the judicially created doctrine of obviousness type double patenting over claims 1, 8, 9, and 12-14 of Goldberg. These rejections are respectfully traversed.

The Office Action additionally rejects, under 35 U.S.C. § 103, of claims 1-4, 10-12, and 15-21 over Goldberg and LaPorta et al., claims 1-10, 12, and 14-21 over Goldberg and Reis et al. (U.S. Patent No. 5,973,613), and claim 13 over Goldberg, Ries et al. and Lemelson (U.S. Patent No. 6,054,928). These rejections are respectfully traversed.

Applicant asserts these rejections are deficient because the Office Action not met the burden of establishing a *prima facie* case of obviousness. In particular, the Office Action has not provided proper motivation to combine the reference teachings. Because there is no motivation to combine the reference teachings, both the double patenting rejections and the rejections under 35 U.S.C. §103 are deficient.

More particularly, no reference or combination of references disclose any benefit or deficiency in LePorta et al. or Ries et al. that would necessitate one of ordinary skill in the art to modify Goldberg to obtain the claimed invention or vice versa. The deficiencies and/or benefits are also not provided by knowledge of one of ordinary skill in the art.

As asserted in the previous Amendments, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on

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applicant's disclosure (MPEP 2142). The prior art must suggest the desirability of the claimed invention (MPEP 2143.01).

Also, according to MPEP § 804, a double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

The Office Action has not provided any benefit or deficiency in LePorta et al. that would necessitate one of ordinary skill in the art to modify Goldberg to obtain the claimed invention or vice versa.

The Office Action admits "Goldberg fails to teach (1) pre-programming each PCU with orthogonal codes that correspond to a plurality of canned messages, (2) each PCU detecting a triggering event that does not originate from and is not controlled by the wireless communication system; and (3) each PCU selecting and transmitting one of the plurality of canned messages in response to the triggering event," (page 8). The Office Action then alleges "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Goldberg as taught by LaPorta because the steps of (1) pre-programming each PCU with orthogonal codes that correspond to a plurality of canned message in addition to each PCU's unique code steps, (2) detecting a triggering event that does not originate from and is not controlled by the wireless communication system, and (3) selecting and transmitting one of the plurality of canned message in response to the triggering event provide an easy way for a recipient to respond to a message with limited bandwidth usage (see LaPorta, Col. 6, lines 56-59 and Col. 13, lines 5-8) while allowing co-channel responses of multiple recipients to be received simultaneously at central controller 102 (see Goldberg, Abstract), thus conserving frequency spectrum," (pages 8-9). Applicant disagrees.

In particular, the mentioned sections of LaPorta et al. do not provide, and none of the other sections of LaPorta et al. provide motivation to combine the teachings of the two-way

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messaging system disclosed in LaPorta et al. with the acknowledge-back communication system disclosed in Goldberg. Goldberg is directed to an ack-back system (col. 3, lines 55-57) and does not disclose usefulness in a system using dynamically customizable messages. LaPorta et al. is directed to a system utilizing dynamically customizable messages (col. 1, lines 10-15) and does not disclose usefulness in an ack-back system.

For example, the section cited by the Office Action, col. 6, lines 56-59, states "The user agent 12 also provides other benefits. Because messages are expanded inside the messaging network 14, the bandwidth on the uplink can be reduced, allowing bandwidth asymmetry on the wireless link." This only discloses the benefits of expanding messages from reply codes such as those discussed at col. 5, lines 36-39 and illustrated in Fig. 9. This does not disclose expanding acknowledgement responses in the acknowledge-back communication system disclosed in Goldberg. More particularly, the reply messages in LaPorta et al. are messages that are destined to be read by humans, thus they must be expanded. To the contrary, in the acknowledge-back system disclosed in Goldberg, identification bit patterns are transmitted to acknowledge receipt of a page to a central controller 102 (col. 4, lines 38, 41-43, and 51-57). These identification bit patterns are not human readable messages. Thus, there is no need to expand messages in Goldberg and col. 6, lines 56-59 does not provide motivation to combine the references.

Furthermore, col. 13, lines 5-8 does not provide motivation. This section only states, "The design of these message types is strongly influenced by the capability of the messaging device. For example, the lack of a keyboard implies that free form messages are impractical." Applicant does not understand how there could be any motivation to combine the references present in this section and the Office Action has not clarified such. Also, this section also is only referencing the human-readable messages discussed above, and not the acknowledgement responses disclosed in Goldberg.

Additionally, the Abstract of Goldberg does not provide motivation to combine the teachings of the two-way messaging system disclosed in LaPorta et al. with the acknowledge-back communication system disclosed in Goldberg. In particular, the Abstract of Goldberg only discloses the benefits of using a bit pattern to identify a portable communication unit (PCU) when responding to a poll requesting the identities of the PCUs. This does not amount to

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motivation to utilize the teachings of Goldberg in the two-way wireless messaging system disclosed in LaPorta et al. More particularly, the process described in the Abstract of Goldberg is a process used in the acknowledgement-back communication system disclosed in Goldberg (col. 3, lines 55-58). There is no disclosure that the two-way messaging system disclosed in LaPorta et al. requires teachings that are used in a acknowledgement-back communication system. Thus, the Abstract of Goldberg does not provide motivation to combine the teachings of the two-way messaging system disclosed in LaPorta et al. with the acknowledge-back communication system disclosed in Goldberg. Furthermore, none of the other sections of Goldberg provide such motivation.

Accordingly, the Office Action has not provided a *prima facie* case of obviousness because it has not provided proper motivation to combine the teachings of the two-way messaging system disclosed in LaPorta et al. with the acknowledge-back communication system disclosed in Goldberg.

Additionally, even if the teachings of Goldberg and LaPorta et al. were combined, such a combination would not result in using a plurality of orthogonal codes corresponding to a plurality of canned message that produces an interference symbol pattern that provides a non-zero probability of correctly decoding at least some of a group of messages. In particular, the combination of the teachings of the two references would only result in a system that uses Goldberg's bit patterns corresponding to a portable communication unit to produce an interference pattern to correctly identify a portable communication unit along with separately using LaPorta et al.'s pre-canned messages to allow user's to easily respond to questions, such as lunch choices, from other users (col. 5, lines 11-27). Thus, even if the teachings of Goldberg and LaPorta et al. were combined, such a combination would not result in the claimed invention.

Furthermore, the Office Action has also not provided any benefit or deficiency in Ries et al. that would necessitate one of ordinary skill in the art to modify Goldberg to obtain the claimed invention or vice versa.

The Office Action admits "Ries fails to teach that the codes corresponding to a plurality of canned messages are orthogonal and are chosen such that when a group of different canned messages are received simultaneously by a local cellular transceiver of wireless processing

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device, the interference symbol patter[n] provides a non-zero probability of correctly decoding at least some of the canned messages and a substantially zero probability of erroneously decoding a canned message not in the group," (page 15). The Office Action goes on to allege "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Reis as taught by Goldberg because the use of the slotted ALOHA protocol and orthogonal codes enable a plurality of pagers to simultaneously transmit canned reply message on the same communications channel while enabling a local cellular transceiver to correctly identify the interfering messages, thus improving the system's functionality and efficiency." (page 16). Applicant disagrees.

In particular, the Office Action has not provided any section of Ries et al. that provides, and in fact, none of the sections of Ries et al. provide motivation to combine the teachings of the personal messaging system using a batch collection protocol disclosed in Ries et al. with the acknowledge-back communication system disclosed in Goldberg. Goldberg is directed to an ack-back system (col. 3, lines 55-57) and does not disclose usefulness in a system using predetermined reply messages. Ries et al. is directed to a personal messaging system that let a user read a paging message and select a stored predetermined reply message (title, abstract) and does not disclose usefulness in an ack-back system.

In fact, the Office Action provides no foundation for any possible motivation to combine the teachings of Ries et al. and Goldberg. The Office Action only makes a conclusory statement regarding motivation. This does not satisfy the requirement of MPEP 2142, which requires there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. In particular, the Office Action does not cite any section of the references providing this motivation and the Office Action does not allege the motivation is in the knowledge generally available to one of ordinary skill in the art. Thus, the Office Action provides no foundation for any possible motivation to combine the teachings of Ries et al. and Goldberg.

Accordingly, the Office Action has not provided a prima facie case of obviousness because it has not provided proper motivation to combine the teachings of the two-way

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messaging system disclosed in Ries et al. with the acknowledge-back communication system disclosed in Goldberg.

Additionally, even if the teachings of Goldberg and Ries et al. were combined, such a combination would not result in using a plurality of orthogonal codes corresponding to a plurality of canned message that produces an interference symbol pattern that provides a non-zero probability of correctly decoding at least some of a group of messages. In particular, the combination of the teachings of the two references would only result in a system that uses Goldberg's bit patterns corresponding to a portable communication unit to produce an interference pattern to correctly identifying a portable communication unit along with separately using Ries et al.'s batch collection protocol to process communication signals during a batch session. Therefore, even if the teachings of Goldberg and Ries et al. were combined, such a combination would not result in the claimed invention.

Thus, there is no motivation to combine any of the references to achieve the invention claimed in independent claim 1, and similarly claimed in independent claims 11 and 16. Accordingly, both the double patenting and the obviousness rejections are deficient.

The Office Action takes Official Notice that slotted ALOHA is a commonly used technique for communications resource assignment in radio based telecommunications. The Office Action further takes Official Notice that (apparently) motivation is based on it being desirable to avoid collisions in a multiple access system and that the slotted ALOHA is a suitable method for reducing collisions in a system with multiple, simultaneous users. Applicant disagrees. Applicant has already established that it would not be obvious to utilize slotted aloha by stating, in the present application, "A large number of devices requesting service at substantially the same time in response to a triggering event can overwhelm classical random access methods, such as slotted aloha. In the prior aloha art, collisions have resulted in loss of data and a need for the colliding devices to retransmit at randomly selected times," (page 1, lines 15-19). Accordingly, Applicant traverses this allegation in accordance with MPEP § 2144.03.

Therefore, Applicant respectfully submits that independent claims 1, 11, and 16 define patentable subject matter. The remaining claims depend from the independent claims and

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therefore also define patentable subject matter. Accordingly, Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. § 101 and 35 U.S.C. § 103.

CONCLUSION

Based on the foregoing amendments and remarks, Applicant respectfully submits this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-21 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

The Commissioner is hereby authorized to deduct any additional fees arising as a result of this Amendment or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

Respectfully submitted,



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